

### **REMARKS**

Applicants have now had an opportunity to carefully consider the Examiner's comments set forth in the outstanding Office Action. The Examiner's rejections are traversed. Reexamination and reconsideration are respectfully requested.

#### **The Office Action**

Claims 1-25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ginter, et al. (US 5,892,900, hereinafter merely referred to as Ginter).

#### **The Present Application**

The present application is directed to a token that dispenses random numbers or codes that are used for authentication purposes. For example, the token is optionally a portable or handheld electronic device. In response to activation of the device, e.g., by pressing a designated button, a codes or random number is selected from a list or set thereof and output on a display. With each activation, the next number or code from the list or memory is dispensed. In this manner, a user is able to selectively dispense numbers or codes from the device one after the other. To use a suitable analogy, the token is like an electronic PEZ dispense, but instead of dispensing individual candies one after the other from the top of a stack of candies stored in the dispenser, the token dispenses individual numbers or codes one after the other from a set or list of codes stored in a memory or other suitable storage device. Suitably, each dispensed code or number may optionally be used as a one-time password or authentication code in connection with a commercial transaction.

#### **The Ginter Reference**

As the Examiner surely appreciates, Ginter is a vast and comprehensive reference that also cites many other U.S. and foreign patent documents and numerous other publications. Yet nowhere within its many pages can Applicants find where Ginter discloses the claimed subject matter of the present application. Moreover, given the completeness of the Ginter reference, surely if the present inventive subject matter were merely an obvious variation, Ginter would have at least mentioned it somewhere. Nevertheless, Ginter does not explicitly disclose or even implicitly suggest the claimed subject matter of the present application. This is largely because Ginter is directed to a completely different problem and/or technical field.

More specifically, Ginter is directed to secure transaction management and electronic rights protection. Ginter relies on the creation of a virtual distribution environment (VDE), and uses a relatively complex system of electronic content controls to implement the security and protections proposed. The focus of Ginter is to provide a system by which digital media transactions (e.g., the purchase of digital sound recordings or movies) can be managed, metered and/or monitored to ensure that the electronic media or product is not being used improperly, i.e., without permission. Such impermissible uses may be, e.g., unauthorized copying of the media.

At best, Ginter is only concerned with authenticating the device (such as a TV, video player, PC, etc.) an individual uses rather than the actual identity of an individual participating in a particular commercial transaction. In any event, Ginter does not disclose the claimed subject matter of the present application. For example, nowhere does Ginter even suggest the type of token described above.

#### **Comments/Arguments**

It is widely accepted that the initial burden of establishing a *prima facie* conclusion of obviousness rests with the Examiner. See, e.g., the Manual of Patent Examining Procedure (MPEP) §2142. In the present instance, the Examiner fails to establish a *prima facie* case of obviousness. Accordingly, the rejections of claims 1-25 are hereby traversed.

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP §2142. Notably, Ginter fails to teach or suggest all the claim limitations. Moreover, the Examiner provides no motivation for making any modifications to Ginter.

When making a rejection under 35 U.S.C. §103, the Examiner is required to set forth in the Office Action: (i) the proposed modification of the reference necessary to arrive at the claimed subject matter, and (ii) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification. See MPEP §706.02(j) (C) and (D). The Examiner in the present case sets forth neither of these requirements in the Office Action. Rather, the Examiner

merely indicates that Ginter does not discuss the permutations of the instant case and that it would have been obvious to adapt Ginter as in the present invention. See, e.g., Office Action page 3, paragraph 6. This merely conclusory statement is without any supporting evidence or rational, and inadequate to maintain a *prima facie* case of obviousness. Nowhere does the Office Action indicate with specificity that any kind of modification to Ginter is being proposed, nor is any motivation recited for making any modification. The fact that the claimed invention may be within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness. See, e.g., MPEP §2143.01(III).

Additionally, the Examiner provides no suitable support for the proposed obviousness rejection. That is, the motivation for any proposed modification is not expressly recited in the prior art and no secondary reference disclosing the motivation or the missing elements has been cited. The Examiner's statements in this regard simply lack any supporting evidence in the record.

Again, the MPEP is instructive on this point. "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP §2143.01. Moreover, it is axiomatic that to establish a *prima facie* case of obviousness as is the Examiner's burden, all the claim limitations must be taught by the prior art. See, e.g., MPEP §2143.03. Inasmuch as Ginter fails to expressly provide the motivation for making the proposed modification and concededly fails to explicitly disclose every claim feature, presumably the Examiner is relying on what is well-known prior art or common knowledge in the art.

Surely, the Examiner is well aware that Applicants are required to seasonably challenge statements by the Examiner that are not supported on the record, and that failure to do so will be construed as an admission by Applicants that the statements are true. See, e.g., MPEP §2144.03. Therefore, in accordance with Applicants' duty to seasonably challenge such unsupported statements, the Examiner is respectfully requested to cite one or more specific references that provide the motivation for any proposed modifications and/or disclose the missing features. Compliance with MPEP §2144.03 mandates that if an Examiner is to properly maintain a rejection then

documentary evidence must be supplied when the Applicants traverse the Examiner's assertions with respect to what is well-known or common knowledge in the art.

Finally, Applicants can find nowhere in Ginter where all the claimed elements and/or features are taught. Nevertheless, with respect to claims 1, 10 and 15, the Examiner merely recites that an array of claimed elements are disclosed by Ginter, and references col. 4, ln. 28 – col. 5, ln. 10. However, the referenced text fails to disclose most if not all of the claimed elements and/or features. Additionally, Applicants have found no text elsewhere within Ginter that in fact discloses the claimed elements and/or features. Should the Examiner contend otherwise, it is respectfully requested that the Examiner specifically recite by column and line number where each one of the particular elements and/or features are disclosed in Ginter as claimed.

More specifically, claim 1 calls for a token for conducting commercial transactions. The token includes: a power source; a unique set of predetermined random numbers; software for selecting and dispensing an unused number from the set of random numbers; a memory for storing the software and the set of random numbers; a display device for displaying the dispensed random number; and, a plurality of buttons, wherein each selection of a button causes the software to select and dispense a previously unused number from the set of random numbers. Ginter discloses no such token. The referenced text (i.e., col. 4, ln. 28 – col. 5, ln. 10) that the Examiner alleges to disclose the foregoing is plainly irrelevant and completely fails to disclose any one of the foregoing elements. That is to say, the referenced text never even mentions: a token, a power source, a set of random numbers, software for selecting and dispensing random numbers, a memory, a display device or a plurality of buttons. Again, should the Examiner contend otherwise, it is respectfully requested that the Examiner specifically recite where each of the foregoing elements is disclosed or which particular elements in Ginter equate to each of the foregoing claimed elements.

Claim 10 calls for a system for conducting commercial transactions. The system includes: a power source; a unique set of predetermined random numbers; software for selecting and dispensing an unused number from the set of random numbers; a memory for storing the software and the set of random numbers; a display device for displaying the dispensed random number; a keypad or keyboard; and, a plurality of virtual buttons. Again, the referenced text that the Examiner alleges to disclose the foregoing is plainly irrelevant and completely fails to disclose any one of the foregoing

elements. In particular, the cited text never even mentions: a power source, a set of random numbers, software for selecting and dispensing random numbers, a memory, a display device, a keypad/keyboard or a plurality of virtual buttons. If the Examiner believes otherwise, it is respectfully requested that the Examiner specifically recite where each of the forgoing elements is disclosed or which particular elements in Ginter equate to each of the foregoing claimed elements.

Claim 15 calls for a method for conducting commercial transactions. The method includes providing a transaction device having: a power source; a unique set of predetermined random numbers; software for selecting and dispensing random numbers; a memory for storing the software and the set of random numbers; a display device for displaying the dispensed random number; and, an account selection means. Again, the cited text that the Examiner alleges to disclose the foregoing is plainly irrelevant and completely fails to disclose any one of the foregoing elements. In particular, the cited text never even mentions: a power source, a set of random numbers, software for selecting and dispensing random numbers, a memory, a display device, or account selection means. As before, if the Examiner should believe otherwise, it is respectfully requested that the Examiner specifically recite where each of the forgoing elements is disclosed or which particular elements in Ginter equate to each of the foregoing claimed elements.

Notably, with respect to claim 15, the Office Action does not even allege that Ginter discloses the claimed steps of: providing an authentication system; selecting via the account selection means a unique account identifier number representing a type of account for conducting a commercial transaction; invoking the software, for each activation of the selection means, to select and dispense a previously unused number from the set of random numbers and display the dispensed number and the unique account identifier in the display device; or providing the authentication system with the account identifier and the dispensed number. The Office Action also does not allege that that Ginter discloses an authentication system that: compares the dispensed number to the next unused number stored on the authentication system; and, accepts the transaction if the dispensed number matches the next unused number stored on the authentication system or rejects the transaction if the dispensed number does not match the next unused number stored on the authentication system. Significantly, with respect to claim 15, the Office Action completely ignores a multitude of claimed features

and/or elements. This is erroneous treatment of the claim and contrary to well accepted examination practices. See, e.g., MPEP §2143.03 ("All words in a claim must be considered in judging the patentability of that claim against the prior art." Citation omitted).

With respect to claim 21, the Examiner cites col. 8, ln. 15-40 of Ginter as disclosing the claimed elements and/or features. Again, the cited text is completely irrelevant and fails to disclose even a single one of the claimed elements and/or features. Moreover, Applicants found no text elsewhere in Ginter that disclosed the claimed elements and/or features. In particular, claim 21 calls for a code dispensing device that includes: storage means for storing a set of codes; signaling means for signaling the dispensing device to dispense one of the codes from the set upon each activation of the signaling means; and, display means for displaying the dispensed codes. Ginter discloses no such code dispensing device. In the cited text, alleged by the Examiner to disclose the foregoing, there is absolutely no mention of a code dispensing device, storage means, a set of codes, signaling means or display means. If the Examiner should believe otherwise, it is respectfully requested that the Examiner specifically recite where each of the foregoing elements is disclosed or which particular elements in Ginter equate to each of the foregoing claimed elements.

Moreover, in rejecting claim 21, the Examiner again fails to establish a *prima facie* case of obviousness. The Office Action fails to set forth any proposed modifications to Ginter, nor does it set forth a motivation for making any modifications.

Accordingly, claims 1, 10, 15 and 21 distinguish patentably over the applied reference, along with claims 2-9, 11-14, 16-20 and 22-25 that depend therefrom.

**CONCLUSION**

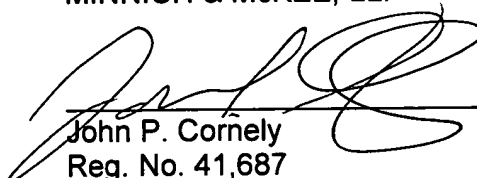
For the reasons detailed above, it is respectfully submitted that all claims remaining in the application are in condition for allowance.

In the event the Examiner considers personal contact advantageous to the disposition of this case, she is hereby authorized to call the undersigned at telephone number listed below.

Respectfully submitted,

FAY, SHARPE, FAGAN,  
MINNICH & McKEE, LLP

March 14, 2006  
Date

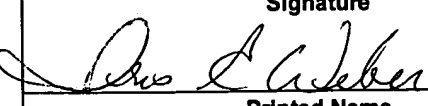
  
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